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| 09/625,967 | 07/26/2000 | Naoyuki Inoue | 000929 | 8413 |

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EXAMINER

SORRELL, ERON J

| ART UNIT | PAPER NUMBER |
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2182

DATE MAILED: 07/03/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

8

Office Action Summary

Application No.

09/625,967

Applicant(s)

INOUE, NAOYUKI

Examiner

Eron J Sorrell

Art Unit

2182

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 July 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- ☐ Interview Summary (PTO-413) Paper No(s). _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

Art Unit: 2182

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-10 and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flannery (U.S. Patent No. 6,424,796) in view of Gilbert (U.S. Patent No. 6,357,011).

3. Referring to claim 1, Flannery teaches an expansion device used for transmission of data between a computer and a data read out device comprising:

a main body connected to the computer (see lines 46-59 of column 4);

a mounting portion provided on the main body in which the readout device is mountable and the readout device being able to read information processing data and to read sound reproducing data from a storage unit storing at least the sound reproducing data (see lines 16-22 of column 3);

Art Unit: 2182

audio circuits for processing the sound reproducing data (see item labeled 310 in figure 5).

Flannery further discloses a first power input portion, and a second power input portion being supplied source power for the expansion device from a second power supply other than the power supply for the computer wherein operations of the audio circuits and the readout device are enabled by supplying source power thereto from the second power input portion when no source power is supplied to the first power input portion (see lines 34-40 of column 5).

Flannery fails to disclose that the first power input portion is supplied with source power for the expansion device from a power supply for the computer, however Flannery does disclose that the means for connecting the expansion device to the host computer can be an IDE/ATA bus, a SCSI bus, **or the like** (emphasis added, see lines 46-59 of column 4).

Gilbert discloses a expansion device with a first and second power input portions wherein the first input portion is supplied with source power for the expansion device from a power supply for the computer (see lines 4-6 of the abstract).

Gilbert discloses the bus is a USB bus, which has wires for distributing power to the peripheral device (see lines 46-59 of column 2).

Art Unit: 2182

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the apparatus of Flannery with the teachings of Gilbert such that the expansion device is connected to the host computer via a USB bus which supplies source power from the computer to the peripheral device. One of ordinary skill in the art would have been motivated to make such modification because USB allows for communication at higher data rates, adds flexibility and reduces complexity as suggested by Gilbert (see lines 31-40 of column 1).

4. Referring to claim 2, Flannery discloses the operating portion for controlling an operation of the readout device is provided in the main body (see lines 1-14 of column 4).

5. Referring to claim 3, Flannery discloses the mounting portion is adapted to selectively and detachably accommodate a plurality of kinds of expansion units other than the readout device (see lines 52-58 of column 1).

6. Referring to claim 4, Flannery discloses an expansion device wherein a second power supply is an external DC power supply (see item labeled 420 in figure 6).

Art Unit: 2182

7. Referring to claim 5, Flannery discloses the second power supply is a battery built thereinto (see item labeled 420 in figure 6).

8. Referring to claim 6, Flannery discloses a host computer (see lines 46-59 of column 4), but fails to explicitly set forth the limitation that the host computer is a notebook computer. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to make the computer of Flannery a notebook computer so it can be easily portable.

9. Referring to claim 7, Flannery discloses a device wherein a plurality of expansion units are a CD-ROM drive, a floppy disk drive, a DVD drive, a memory card drive, and a hard disk drive (see lines 65-67 of column 2 and lines 1-15 of column 3).

10. Referring to claim 8, Flannery discloses a battery for use in the apparatus but is silent on the voltage of the battery. Gilbert discloses the USB cable carries a voltage of 5 volts (see lines 47-59 of column 2).

It is well know in the art that several types of batteries output voltages less than 5 volts (for example AA, AAA, lithium

Art Unit: 2182

batteries, etc.) These types of batteries are typically used in such portable devices because they are small and inexpensive.

11. Referring to claim 9, Flannery discloses the CD-ROM drive has both a decoding circuit for decoding digital data and a decoding circuit for decoding analog data and wherein switching between a digital data signal and an analog music signal is automatically performed according to the kind of the storage medium (see items labeled 310, 312, and 318 in figure 5 and 34-67 of column and lines 1-8 in column 5).

12. Referring to claim 10, Flannery discloses the readout device indicates a playing track number and a piece number in a display device of the operating portion when the storage medium is an audio disk (see item labeled 210 in figure 4A).

13. Referring to claim 12, Gilbert discloses that the host device is connected to the expansion device by a cable (see item labeled 30 in figure 1).

14. Referring to claim 13, Gilbert discloses the host device is connected to the expansion device by connecting a connector

Art Unit: 2182

provided in the host directly to a connector provided on the expansion device (see item labeled 30 in figure 1).

15. Referring to claim 14, Flannery discloses a connector is installed in the mounting portion provided in the main body, wherein a corresponding connector is provided in the readout device, and wherein the readout device is connected to the main body only by inserting the readout device into the mounting portion (see lines 16-37 of column 3).

16. Referring to claim 15, Gilbert discloses that the cable is detachable from the host device (see lines 46-52 of column 2).

17. Claims 11 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flannery in view of Gilbert as applied to claims 1-7,9,10,12,14 and 15 above, and further in view of Ozawa.

18. Referring to claim 11, Flannery and Gilbert fail to disclose the battery being chargeable.

Ozawa teaches an analogous apparatus wherein the battery is chargeable (see lines 14-17 of column 5).

Art Unit: 2182

It would have been obvious to one of ordinary in the art at the time of the applicant's invention to further modify the combination of Flannery and Gilbert such that the battery is rechargeable as to save the user money by not having to purchase new batteries.

19. Referring to claim 16, Ozawa discloses the second power input portion is provided in the first input portion (see items labeled 53 and 62 in figure 7 and the associated connections).

Response to Arguments

20. Applicant's arguments with respect to claim 1 has been considered but are moot in view of the new ground(s) of rejection.

Conclusion

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made. Applicant must also show how the amendments avoid such references and objections. See 37 CFR § 1.111(c).

Art Unit: 2182

The following U.S. Patent is cited to further show the state of the art as it pertains to external expansion devices:

U.S. Patent No. 6,456,491 to Flannery et al.

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eron J Sorrell whose telephone number is 703 305-7800. The examiner can normally be reached on Monday-Friday 9:00AM - 5:30PM.

Art Unit: 2182

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffery A Gaffin can be reached on 703 308-3301. The fax phone numbers for the organization where this application or proceeding is assigned are 703 746-7239 for regular communications and 703 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-3900.

EJS
July 1, 2003



JEFFREY GAFFIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100